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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,851	05/09/2002	Serge Saint-Dizier	0512-1007	2474
466	7590	06/18/2004	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			MUSSEY, BARBARA J	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,851

Applicant(s)

SAINT-DIZIER, SERGE

Examiner

Barbara J. Musser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/19/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 20 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 20, it is unclear what relationship, if any, exists between the main and the main blank. It is suggested that either the claim indicate that the end that the main and secondary blanks form the main and secondary coatings or that coating be changed to blank.

Claim 28 recites the limitation "the non-coated portion" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is unclear what is meant by the claim as the main blank is always cut to a shape whose outline corresponds to the boundary between the main coating and portions not having the main coating. For the purposes of examination, it is assumed that the outline corresponded to the boundary between the main coating and the secondary coating as no non-coated portion has been defined.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 20, 21, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Barber et al.(U.S. Patent 6,451,232).

Barber et al. discloses forming a coated part by applying a secondary blank(18,20) cut to a desired shape to a main blank(16) cut to a desired shape, applying clamps to the edge of the main blank, placing the combination in a mold, injecting foam behind the main blank so that it is between the secondary blank and the foam, allowing the foam to set, removing it from the mold, and cutting off the excess portions of the main blank.(Figures 4 and 5; Col. 3, ll. 28- Col. 5, ll. 33) The foam forces the combination to take the shape of the mold. It is noted that the claim does not require that the final part comprise a structure where the main blank surrounds a portion of the secondary blank.

Regarding claim 21, the secondary blank is bonded to the main blank via an adhesive.(Col. 2, ll. 35-36)

Regarding claim 29, the main blank is essentially rectangular in shape.(Figure 4)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20-22, 27, 28, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moffit et al.(WO 98/31524) in view of Barber et al.

Moffit et al. discloses applying a pre-cut second layer to a pre-cut first larger layer, placing the composite in a mold, closing the mold so that the composite takes the shape of the mold, and injection molding foam behind it so that the second layer remains visible.(Abstract; Figure 4) The reference does not disclose placing the composite in a clamping frame which positions the composite in the mold and trimming off the excess clamping margin after molding. Barber et al. discloses placing a two layer composite in a mold using a clamping frame, injection molding behind it, and cutting off the clamping margin.(Figure 5; Col. 5, ll. 24-36) It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the first layer of Moffit et al. larger and use a clamping frame with it, the clamping margin of which is then removed after molding since this would allow accurate placement of the composite every time particularly since Moffit et al. does not show the edges of the mold and discloses further processing can occur to the product.(Pg. 5, ll. 15-16)

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Regarding claim 21, the secondary layer is secured to the main layer using adhesive.(Pg. 2, ll. 8)

Regarding claim 22, one in the art would appreciate that when the main layer is held in a clamping frame and the mold is closed, the injection of resin forces the layers against the mold surface, stretching them.

Regarding claim 27, while Barber et al. only discloses holding a portion of the main layer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to clamp around the entire periphery of the main layer since this would insure even stretching of the material during the molding process.

Regarding claim 28, while the references do not disclose the secondary layer being at the edge of the main layer, one in the art would appreciate that this would depend on the desired final location of the secondary layer in the product and it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the secondary layer at the edge of the main layer when it was desired to have the secondary layer at the edge of the main layer in the final product and to not clamp the secondary layer as using that section as a clamping margin would increase the cost since a portion of the secondary layer would be discarded.

Regarding claim 30, Moffit et al. discloses forming the composite by placing the main layer in a die, placing the secondary layer in a recess in a punch which cooperates with the die, applying the punch to the main layer, and removing it, leaving the secondary layer attached to the main layer.(Figures 1, 2A; Pg. 2, ll. 10-11; Pg. 4, ll. 1-13)

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Regarding claim 31, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a common reference system for all the parts as this would insure proper alignment of all the parts and layers.

7. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moffit et al. and Barber et al. as applied to claim 20 above, and further in view of Spengler et al.(U.S. Patent 5,076,880).

The references cited above do not disclose a foam layer being between the secondary layer and the main layer. Spengler et al. discloses secondary layers made of multiple sheets including one having a foam padding.(Col. 5, ll. 36-39) The foam padding is smaller than the size of the secondary layer so that it is completely covered by the secondary layer.(Figure 4) It would have been obvious to one of ordinary skill in the art at the time the invention was made to place a small piece of foam between the main layer and the secondary layer since this is a known type of insert in the trim panel of an automobile(Abstract), the same type of product as Moffit et al.(Abstract), and since this allows the trim panel to have different density foams in different locations.

Regarding claims 24 and 25, Spengler et al. states the secondary layers may be made in any manner known in the art.(Col. 5, ll. 41-44) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use adhesive to bond the foam to the secondary layer since this would prevent movement of the layers relative to one another and since Spengler et al. discloses the secondary layers can be made in any manner known in the art.(Col. 5, ll. 41-44)

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8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moffit et al. and Barber et al. as applied to claim 20 above, and further in view of Savonuzzi (EP 0482270A1).

The references cited above do not disclose a thermal protection sheet between the main layer and the foamed material. Savonuzzi discloses applying a thermoplastic shielding layer to the back of layers which are to be injection molded against to prevent the injectable material from permeating through the main layer. (Abstract) It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a thermal protection layer to the back of the main layer to prevent the injected resin from permeating through the main layer damaging the product and to prevent heat damage to the main layer. (Abstract)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is **(571) 272-1222**. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*BJM*  
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